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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,194

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Christopher J. Stone

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Motorola, Inc.

Law Department

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EXAMINER

CHOWDHURY, NIGAR

ART UNIT

PAPER NUMBER

2621

NOTIFICATION DATE

DELIVERY MODE

01/26/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

Office Action Summary	Application No. 10/743,194	Applicant(s) STONE, CHRISTOPHER J.	
	Examiner NIGAR CHOWDHURY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim(s) 1-10, 21 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, method of claim 1-10, and 21 are not tied to any apparatus.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

¹ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9-16, 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,642,939 by Vallone et al.

3. Regarding **claim 1**, a method for recording a broadcast program, method comprising the steps of:

- receiving a transport packet stream in which the program is embodied, transport packet stream including an indicator denoting a time at which program ends (fig. 1, 18, 28 col. 5 lines 4-55, col. 23 lines 18-col. 24 lines 7);
- electronically storing transport packet stream (fig. 1, 13 col. 5 lines 36-44, col. 13 lines 11col. 14 lines 29);
- extracting indicator from the transport packet stream (col. 6 lines 8-19, col. 8 lines 66-col. 9 lines 18, col. 23 lines 18-col. 24 lines 7);
- decoding extracted indicator (fig. 1, col. 5 lines 4-64); and

- terminating the step of electronically storing transport packet stream in accordance with the time denoted by indicator (fig. 1, 13, col. 23 lines 18-col. 24 lines 7, col. 13 lines 11col. 14 lines 29).
4. Regarding **claim 2**, the method wherein transport packet stream is received in accordance with a digital transport protocol (col. 5 lines 4-35).
5. Regarding **claim 3**, the method wherein digital transport protocol includes video compression (col. 5 lines 4-35).
6. Regarding **claim 4**, the method wherein transport packet stream is an MPEG-2 bit stream (col. 5 lines 4-35, col. 7 lines 66-col. 8 lines 8).
7. Regarding **claim 5**, the method wherein indicator is located in an MPEG-2 system table (col. 5 lines 4-35, col. 7 lines 66-col. 8 lines 8).
8. Regarding **claim 6**, the method wherein said MPEG-2 system table is a program map table (col. 5 lines 4-35, col. 7 lines 66-col. 8 lines 8).
9. Regarding **claim 9**, the method wherein the electronically storing step is performed on a magnetic storage device (col. 5 lines 36-44, col. 13 lines 11-25).

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10. Regarding **claim 10**, the method wherein the electronically storing step is performed on an optical storage device (col. 13 lines 54-58).

11. **Claim 11** is rejected for the same reason as discussed in the corresponding claim 1 above.

12. **Claim 12** is rejected for the same reason as discussed in the corresponding claim 2 above.

13. **Claim 13** is rejected for the same reason as discussed in the corresponding claim 3 above.

14. **Claim 14** is rejected for the same reason as discussed in the corresponding claim 4 above.

15. **Claim 15** is rejected for the same reason as discussed in the corresponding claim 5 above.

16. **Claim 16** is rejected for the same reason as discussed in the corresponding claim 6 above.

17. **Claim 19** is rejected for the same reason as discussed in the corresponding claim 9 above.

18. **Claim 20** is rejected for the same reason as discussed in the corresponding claim 10 above.

19. **Claim 21** is rejected for the same reason as discussed in the corresponding claim 1 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 7-8, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,642,939 by Vallone et al. in view of US 6,847,779 by Pietraszak.

21. Regarding **claim 7**, Vallone discloses transport packet stream in which the program is embodied and transport packet stream including an indicator (fig. 1, 18, 28 col. 5 lines 4-55, col. 23 lines 18-col. 24 lines 7) but fails to disclose indicator is incorporated into transport packet stream by a universal data format

Pietraszak discloses indicator is incorporated into transport packet stream by a universal data format (col. 1 lines 30-43)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Vallone's system to include a universal data format, as taught by Pietraszak, for user to have more flexibility to communicate and also which is easily be viewed.

22. **Claim 8** is rejected for the same reason as discussed in the corresponding claim 7 above.

23. **Claim 17** is rejected for the same reason as discussed in the corresponding claim 7 above.

24. **Claim 18** is rejected for the same reason as discussed in the corresponding claim 7 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NC
01/16/2009

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621